

Attorney Docket: 26274  
Serial No.: 10/506,407

**REMARKS**

Upon entry of the forgoing amendments claims 31-35, 40-44, 67-69, 74-79 and 84 are pending in the application. Claims 36-39, 45-66, 70-73 and 80-83 have been withdrawn. Claims 31 and 44 have been amended. The amendments do not introduce any new subject matter within the meaning of 35 U.S.C. §132. Therefore, entry of the amendments is respectfully requested.

**CLAIM OBJECTION**

The Examiner has objected to claim 44 as being in improper dependent form and suggested correction. Applicants respectfully thank the Examiner for her comments and submit that claim 44 has been amended accordingly. Therefore, Applicants request that the Examiner reconsider and withdraw the object to claim 44.

**REJECTIONS UNDER 35 U.S.C. §102(b)**

**Jackson, et al.**

The Examiner has rejected claims 31-32, 34 and 84 as being anticipated by Jackson, et al., in U.S. Patent No. 5,578,641.

Applicants traverse this rejection.

Jackson, et al. relates to cosmetic compositions having an anti-aging effect in that the compositions treat "dry, ageing or damaged skin to reduce moisture loss" by enabling stimulation of the synthesis of ceramides in the epidermis by the application of precursors of ceramides and/or by stimulation of the activity of enzymes responsible for catalyzing the steps in the biosynthetic pathway that yields ceramides. See, col. 13, lines 15-29. Phytosphingosine is taught by Jackson, et al. as a ceramide precursor.

In contrast, the instant subject matter is directed to a novel method of use of phytosphingosine, as well as of its cosmetically

acceptable salts, particularly of its hydrochloride, as a slimming agent for use on selected parts of the body.

Parts of the body needing a slimming effect according to the instant subject matter (for example, hips, thighs, or other parts of the body in need of a slimming effect) are not the same as those in need of anti-aging effect, as taught by Jackson, et al., such as the face and neck. It Applicants' position that because the teachings of Jackson, et al. are limited to application of compositions to areas such as the face and neck for anti-aging reasons, Jackson, et al. do not teach a method of selecting an area of the body in need of slimming treatment and applying the instant compositions thereto to obtain a slimming effect. Indeed, Jackson, et al. is silent with respect to any teachings regarding slimming treatments or application to parts of the body needing slimming treatment.

It is further Applicants' position that the instant claims as written are clearly directed to application of compositions to areas of the body in need of a slimming effect in order to produce said slimming effect and that the instant claims are not anticipated in view of the limited teachings of Jackson, et al., which fails to teach these limitations. However, in the interest of the furtherance of prosecution, Applicants have amended claim 31 to clearly include a step of selecting an area of the body to which the slimming treatment is needed or desired. As such, the claims are clearly not taught by Jackson, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claim 31-32, 34 and 84.

**Streekstra, et al.**

The Examiner has rejected claims 31-34 and 84 as being anticipated by Streekstra, et al., in WO 00/53568.

Applicants traverse this rejection.

Streekstra, et al. teach sphingoid base derivatives, specifically salts of thereof, and their use in compositions for topical use, and particularly, for the treatment of undesirable and/or abnormal conditions associated with dry skin, inflammation and/or microbial activity. These may include eczema, psoriasis, atopic dermatitis, acne, dandruff, mouth and/or lip infections, mycoses, various other skin infectious diseases or vaginal infections, as well as, wounds, burns, and overall normalisation of skinflora. See page 4, lines 15-21.

While it is conceivable that parts of the body needing a slimming effect according to the instant subject matter may coincide with areas wherein the abnormal conditions which are the focus of Streekstra, et al. occur, Applicants are of the position that this reference does not teach selection of a part of the body in need of a slimming effect and application thereto of the instant compositions to obtain said slimming effect. In fact, Streekstra, et al., are completely silent with respect to the instant subject matter, i.e., slimming treatments, and there is no reason that the parts of the body which are concerned with the treatments of the instant application and those taught in Streekstra, et al. should

be viewed as the same.

It is further Applicants' position that the instant claims as written are clearly directed to application of compositions to areas of the body in need of a slimming effect in order to produce said slimming effect and that the instant claims are not anticipated in view of the limited teachings of Streekstra, et al., which completely fails to teach these limitations. However, in the interest of the furtherance of prosecution, Applicants have amended claim 31 to clearly include a step of selecting an area of the body to which the slimming treatment is needed or desired. As such, the claims are clearly not taught by Streekstra, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claim 31-34 and 84.

**REJECTION UNDER 35 U.S.C. §102(b)**

**Park, et al.**

The Examiner has rejected claims 31-32, 34 and 84 as being anticipated by Park, et al., in U.S. Patent No. 6,372,236.

Applicants traverse this rejection.

Park, et al. teach compositions which may comprise phytosphingosine and the use of said composition in the treatment of various skin diseases, such as atopic dermatitis, as well as for their anti-microbial, anti-wrinkling and anti-inflammatory effects.

Again, parts of the body needing a slimming effect according to the instant subject matter are not the same as those taught by Park, et al. It Applicants' position that because the teachings of Park, et al. are limited to application of compositions to specific areas for reasons other than those which are subject of the instant subject matter, Park, et al. do not teach a method of selecting an area of the body in need of slimming treatment and applying the instant compositions thereto to obtain a slimming effect. As with the previous references, Park, et al. is silent with respect to any teachings regarding slimming treatments or application to parts of the body needing slimming treatment.

It is further Applicants' position that the instant claims as written are clearly directed to application of compositions to areas of the body in need of a slimming effect in order to produce said slimming effect and that the instant claims are not anticipated in view of the limited teachings of Park, et al., which fails to teach these limitations. However, in the interest of the furtherance of prosecution, Applicants have amended claim 31 to clearly include a step of selecting an area of the body to which the slimming treatment is needed or desired. As such, the claims are clearly not taught by Park, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claim 31-32, 34 and 84.

**REJECTIONS UNDER 35 U.S.C. §103(a)**

**Jackson, et al. in view of Streekstra, et al.**

The Examiner has rejected claim 33 as being anticipated by Jackson, et al., above, and further in view of Streekstra, et al., above.

Applicants traverse this rejection.

The teachings of Jackson, et al. and Streekstra, et al. are discussed above.

As stated above, Applicants are of the position that neither reference teaches selection of a part of the body needing a slimming effect according to the instant subject matter (for example, hips, thighs, or other parts of the body in need of a slimming effect). Because the teachings of both Jackson, et al. and Streekstra, et al. are limited to application of compositions to areas in specific areas and reasons which differ from those of the instant application, each is also silent with respect to selecting a specific part of the body in need of slimming treatment.

It is further Applicants' position that the instant claims as written are clearly directed to application of compositions to areas of the body in need of a slimming effect in order to produce said slimming effect and that the instant claims are not anticipated in view of the limited teachings of Jackson, et al.,

and Streeksta, et al. both of which fail to teach these limitations. However, in the interest of the furtherance of prosecution, Applicants have amended claim 31, from which claim 33 depends, to clearly include a step of selecting an area of the body to which the slimming treatment is needed or desired. As such, the claims are clearly nonobvious in view of Jackson, et al. and Streekstra, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claim 33.

**Jackson, et al. in view of Bombardelli, et al.**

The Examiner has rejected claims 35, 40-42, 67, 69 and 74-76 as being anticipated by Jackson, et al., above, and further in view of Bombardelli, et al., in U.S. Patent No. 5,679,358.

Applicants traverse this rejection.

The teachings of Jackson, et al. are discussed above.

Bombardelli, et al., the secondary reference, does not remedy the shortcomings of Jackson, et al. The teachings of Bombardelli, et al. are directed to the use of esculoside alone or in combination with adenylate cyclase stimulators, such as forskolin or Salvia miltiorrhiza diterpenes and/or with phosphodiesterase inhibitors, such as apigenine-skeleton dimeric flavones, in topical formulations for the treatment of peripheral vasculopathies related to an impaired peripheral microcirculation, cellulitis or unesthetisms.



As stated above, Applicants are of the position that Jackson, et al. does not teach selection of a part of the body needing a slimming effect according to the instant subject matter, i.e., hips, thighs, or other parts of the body in need of a slimming effect. Bombardelli, et al. does not completely remedy the deficiencies in Jackson, et al. Specifically, Bombardelli, et al. teaches vasculopathes such as cellulitis and discloses the use of an agent stimulating adenylate cyclase in combination with esculoside.

As such, the claims are clearly nonobvious in view of Jackson, et al. and Bombardelli, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claims 35, 40-42, 67, 69 and 74-76.

**Jackson, et al. in view of Andre, et al.**

The Examiner has rejected claims 35, 40, 44, 67, 69 and 74-76 as being anticipated by Jackson, et al., above, and further in view of Andre, et al., in U.S. Patent No. 5,709,864.

Applicants respectfully note that the Action listed these claims rejected under 35 U.S.C. §101(a) at page 22. However, based on the substance of the rejection and for the sake of compactness of prosecution, Applicants, for purpose of this response, will assume that this is a typographical error, which should read 35 U.S.C. §103(a).

Applicants traverse this rejection.

The teachings of Jackson, et al. are discussed above.

Andre, et al. fail to remedy the failures of the primary reference. Andre, et al. teach a cosmetic or a pharmaceutical composition, in particular a dermatological composition. The composition is characterized in that it comprises a cosmetically or pharmaceutically, and in particular dermatologically, effective quantity of an extract of a plant of genus Tephrosia, in particular an extract of the species Tephrosia purpurea. According to the invention, it has been discovered that the extract of the plant of genus Tephrosia is useful in preparing a cosmetic, pharmaceutical, and in particular dermatological composition. The compositions are primarily directed to anti-aging applications.

As such, the claims are clearly nonobvious in view of Jackson, et al. and Andre, et al. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw this rejection to claims 35, 40, 44, 67, 69, 74 and 78-79.

#### **CONCLUSION**

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this

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matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,

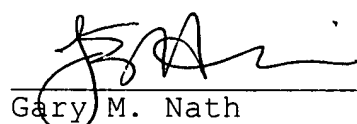
**NATH & ASSOCIATES**

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